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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/578,311

01/03/2007

Adrian Menzell

A-10047

5742

7590

07/11/2008

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EXAMINER

CHIESA, RICHARD L

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

07/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/578,311 | Applicant(s) MENZELL ET AL. | |
| | Examiner Richard L. Chiesa | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>May 4, 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The preliminary amendment filed on May 4, 2006 has been entered.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The drawings filed on May 4, 2006 are accepted by the examiner.

Specification

4. The disclosure is objected to because of the following informalities: (A) The specification fails to indicate that this case is the national stage of International Application No. PCT/AU04/01518 filed on November 3, 2004. (B) The specification is replete with grammatical and/or typographical errors. For example, the word “increase” at various locations should apparently be changed to --increased-- and the word “form” (page 3, line 11) should apparently be changed to --from--. Appropriate correction is required.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 7, 8, and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,568,901 to Adam. Adam (note Figures 1-5) discloses a fuel treatment apparatus and process with magnets 24-26

Art Unit: 1797

positioned in a Y-shaped configuration in a plurality of channels around a fuel line 14 within a tubular cover 12 as claimed (35 USC 102b). It would appear that Adam may not explicitly state the use of channels. However, the end surfaces 51 shown in Figures 4 and 5 form channels or enclosures for placement of the magnets. Consequently, it is inherent or at least would have been readily obvious to one of ordinary skill in the art (35 USC 103a) that magnets are positioned in channels in the Adam fuel treatment device and process.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam in view of Canadian Patent No. 2,169,028 to Broderick. Adam, as described above in paragraph 8, discloses a fuel treatment apparatus and process substantially as claimed with the possible exception of both neodymium and ferrite magnets. In any case, Broderick (note page 9, lines 1-17) teaches the well-known use of both neodymium and ferrite magnets in a fuel treatment apparatus and process for the purpose of enhancing the polar fields and for this same reason it would have been obvious to one of ordinary skill in the art to employ such an expedient in the Adam fuel treatment apparatus and process.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adam in view of U.S. Patent No. 6,763,811 to Tamol, Sr. Adam, as described above in paragraph 8, discloses a fuel treatment apparatus and process substantially as claimed with the apparent exception of magnet positioning within a fuel line. However, Tamol, Sr. (note col. 1, lines 15-34) teaches the well-known use of locating fuel treating magnets either on or within a fuel line for the purpose of increasing fuel efficiency. Therefore, it would have been obvious to one having ordinary skill in

Art Unit: 1797

the art to position fuel treating magnets either on or within the Adam fuel line in order to enhance fuel efficiency as taught by Tamol, Sr.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adam in view of U.S. Patent No. 6,456,178 to Chiu. Adam, as described above in paragraph 8, discloses a fuel treatment apparatus substantially as claimed with the apparent exception of an elongated tubular cover opening on the wall of the tubular covering. In any case, Chiu (note ref. num. 14, Figs. 1-5, and col. 2, lines 1-13) teaches this well-known expedient in a fuel treating apparatus in order to facilitate assembly and for this same reason it would have been obvious to employ the expedient in the Adam fuel treating apparatus.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. These references have been cited as art of interest to show other magnetic fluid treatment systems.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Chiesa whose telephone number is (571) 272-1154.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane S. Smith, can be reached at (571) 272-1166.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (571) 272-1700.

Facsimile correspondence must be transmitted through (571) 273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard L. Chiesa

July 3, 2008

**/Richard L. Chiesa/
Primary Examiner
Art Unit 1797**